UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,420	09/21/2000	Mariko Okamoto	07336.0003-00000	8873

22852 7590 09/17/2002

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20006

EXAMINER	
FUBARA, BLESSING M	
ART UNIT	**PAPER NUMBER**
1615	

DATE MAILED: 09/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/667,420	Applicant(s) OKAMOTO ET AL.	
	Examiner Blessing M. Fubara	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 August 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Examiner acknowledges receipt of response filed 08/08/02.

Claim Rejections - 35 USC § 103

1. Claims 1-41 remain rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-021227 and McEleney et al. (US 5,567,420).

Applicants ague that there is no incentive to combine the two references and that the examiner used applicants' invention as a "guide in recreating it from the references" and thus an improper hindsight reconstruction was made. Further more, applicants state that the references failed to teach "at least one ingredient chosen from pigments and fillers, **wherein the at lest one ingredient has been surface treated by at least one water repellant and oil repellant agent**." Applicants further state that unexpected result will not be provided because the office failed to establish prima facie case of obviousness and also that the examiner failed to consider the data on page 11 of the specification.

2. Applicant's arguments filed 08/08/02 have been fully considered but they are not persuasive.

In response to applicants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to issue raised about non-consideration of data on page 11 of the specification, it is noted that the data gives result in terms of very good, good, poor and fair and these qualifications are relative terms. It is also noted that only formulation 1 which is applicants' and which is polyacrylamide based is the only formula that is treated with perfluoroalkyl phosphate. Formulations 4 and 5, which are also polyacrylamide bases are not treated with perfluoroalkyl phosphate. The comparison is not parallel and the relative terms used in that table fail place the data in Table 1 in the category of unexpected result.

Therefore, a proper data showing the criticality of surface treated pigments or fillers would be necessary to satisfy the requirement of a showing. Secondly, the agent employed to surface treat the pigments or fillers should be the same for all the formulations and should be disclosed in the written description to avoid the introduction of new matter.

In citing Geiger, applicants failed to show that in that case more than two references were combined. In the present case two references are combined which meets the premises of In re Kerkhoven. Also the Geiger case is directed to a method and here, the claims are directed to composition and Kerkhoven is appropriate.

The rejection is given below:

JP 11-021227 discloses a gel composition comprising 1.0-80.0 weight percent polyacrylamide, Vaseline or ceresin, 0.1-20.0 weight percent polyoxyethylene sorbitan fatty acid ester as the non-ionic surfactant and organopolysiloxane (abstract). Applicants admitted on page 3 of the remarks filed 11/15/01 that pigments and fillers may be used in Takeshi's composition and thus Takeshi's composition may comprise pigments and fillers. The JP

reference in the translation provided by applicants suggests that pigments and fillers may be used in the gel composition.

McEleney discloses a skin care composition. The composition comprises formulations selected from the group consisting of lotions, **gels**, creams, moisturizers, mousses and ointments. The formulation comprises petrolatum, pigments, polyoxyethylene sorbitan fatty acid ester, anionic surfactants, polyacrylamide, preservatives and sunscreening agents. McEleney teaches polyacrylamide as a thickener and as a film former in amounts of from 0.1-10%. See abstract, column 5, lines 3-8, column 6, lines 30-67, column 8, lines 1- 45 and claims 10, 16, 17, 24 and 32.

The teachings of both references are directed to cosmetic composition. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of JP 11-021227 in the manner disclosed by McEleney. One having ordinary skill in the art would have been motivated to prepare a third composition comprising polyacrylamide, non-ionic surfactant, pigments, petrolatum, Vaseline or ceresin, organopolysiloxane, preservatives and sunscreening agents by combining the two compositions taught individually in the prior art for the same very cosmetic purpose. The expected result from the combined teachings of the reference is a composition comprising 1.0-80% polyacrylamide, , Vaseline or ceresin. 0.1-20.0 weight percent polyoxyethylenesorbitan fatty acid ester as the non-ionic surfactant, organopolysiloxane, petrolatum, pigments, preservatives and sunscreening agents.

"It is prima facie obvious to combine two compositions each of which is taught by the art to be useful for the same purpose, in order to form a third composition to be used

for the very same purpose....[T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Although the prior art is silent on treating the surface of the pigments and fillers, in the absence of unexpected results, one of ordinary skill in the art would expect the untreated surface of a pigment or filler to provide similar results as the treated surface. In general, where a composition is taught in the prior art, applicants must provide a showing of unexpected result for surface treated pigment or filler over a pigment or filler whose surface is untreated.

The comprising language of the claims does not exclude the other ingredients of the prior art from the composition of the examined application.

No claim is allowed.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is 703-308-8374. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Blessing Fubara
September 13, 2002

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600